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REMARKS

The Examiner's action rejects Claims 1-20. This response cancels claims 1-9 without prejudice to applicant filing one or more continuation applications having claims directed to the canceled claims; amends claim 15; and adds Claims 22-26. Claims 1-20 and 22-26 are pending.

Support for amendment to Claim 15 is found in Figure 3, which illustrates housing 47 and actuator lever 50. Support for added Claims 22-26 is found in Figure 3 and page 8, lines 25-33. No new matter is added.

Rejection of Claims 10-20:

Claims 10-20 are rejected as obvious over US 6,533,797 (Stone) in view of US 6,786,865 (Dhindsa), and further in view of US 5,152,278 (Clayman). It is respectfully urged that this rejection is improper for at least the following reasons.

The Examiner states that Stone and Dhindsa are silent with respect to a surgical device with a flexible member having a length of at least 0.5 meters. The Examiner states that because Clayman teaches an "analogous" device relating to an endoscope through which apparatus such as cutters, balloons, aspirators, and the like with rigid or flexible shafts can be inserted, it would, according to the Examiner, be obvious to include a flexible member in the apparatus of Stone and Dhindsa.

It is respectfully urged that the Examiner has not made out a prima facie case of obviousness.

A prima facie case of obviousness requires that three basic criteria be met: 1. A suggestion or motivation in the prior art to modify or combine reference teachings; 2. A reasonable expectation of success; and 3. The references when combined must teach or suggest all the claim limitations.

It is respectfully urged that the Examiner has not provided the motivation in the prior art for making the combination of Stone with Dhindsa and Clayman. In particular, the Examiner has

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not shown motivation in the prior art for modifying the Stone device. Instead, it is respectfully urged that the Examiner is merely relying on improper hindsight reliance on the Applicants disclosure to selectively pick and choose among various parts of three different prior art references to reconstruct the applicants' invention.

Further, it is respectfully urged that the Examiner has selectively ignored various portions of the cited references in making the rejection. For instance, Clayman at column 2, lines 16-37 explains that the Clayman device provides an endoscope whereby a single hand of the operator can be used to support the endoscope and fingers of that hand can be used to feed a surgical apparatus into the body cavity, opening or conduit. Clayman then goes on to explain the other hand is free to activate the surgical apparatus. (See line 29 of column 2).

It is respectfully urged that one reading Clayman would not be motivated to modify Stone or Dhindsa to provide the subject matter of Claim 10. The subject matter of Claim 10 recites, among other things, a handle with an actuator for operating an end effector through a flexible member, where the handle is adapted to be gripped by a single hand, and wherein the actuator is adapted to be operated by the same handle holding the handle while the thumb and index finger of the same hand holding the handle are free to grip and advance the flexible member.

It is respectfully urged that Clayman, which teaches holding an endoscope and feeding a surgical apparatus with one hand, while activating the surgical apparatus with the other, is not properly used as motivation to provide the device of Claim 10, where the same hand is used to actuate the end effector as is used to grip and advance the flexible member. In fact, the Examiner's proposed combination and modification seem to be contrary to the very teachings of Clayman.

Additionally, it is respectfully urged that there is no teaching or suggestion to employ the device of Stone with a flexible member merely because Clayman teaches that various surgical devices, which could be flexible, can be used with an Endoscope. Using this rational, any of a multitude of combinations of selectively chosen elements taken from the two (or three) references could be used to reconstruct a claimed invention. It is respectfully

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urged that merely because Clayman teaches that certain surgical devices can be used with an endoscope does not amount to motivation to modify another reference (Stone), absent some teaching or suggestion that such a modification would be desirable.

With respect to Claim 15, as amended, it is respectfully urged that even if one combined and modified the references as suggested by the Examiner, the resulting combination would not teach or suggest a device having a handle with an actuator as recited in Claim 10, and further where the actuator comprises a lever adapted to be squeezed between fingers of the hand holding the handle and a housing portion of the handle.

With respect to Claim 16, it is respectfully urged that the rejection is improper for reasons set forth above with respect to Claim 10.

With respect to Claim 18, it is respectfully urged that one considering the three references together would not be motivated to provide the instructions recited in Claim 18, where Clayman specifically seeks to feed a surgical apparatus with one hand that holds an endoscope, while using the other hand to activate the surgical apparatus. (See column 2, lines 16-37 of Clayman).

With respect to added Claim 22 (and dependent claims 23-26), it is respectfully urged that even if one combined and modified the references as suggested by the Examiner, the combination would not provide the subject matter of the new claims. For instance, even if one combined the references as suggested by the Examiner, it is respectfully urged the combined teachings would not provide a handle adapted to be gripped by a single hand; an elongate flexible member, and end effector; where the handle includes an actuator and release as recited in Claim 22.